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No. 98-239

In the Supreme Court of the United States

OCTOBER TERM, 1998

HESTER INDUSTRIES, INC., PETITIONER,

v.

STEIN, INC., RESPONDENT.

On Petition For A Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

SUPPLEMENTAL BRIEF FOR THE RESPONDENT

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SUPPLEMENTAL BRIEF FOR THE RESPONDENT

Pursuant to Supreme Court Rule 15.8, Respondent Stein, Inc. ("Stein") submits this Supplemental Brief to address new "authority" raised in the Reply Brief of Petitioner Hester Industries, Inc. ("Hester")—namely, Judge Clevenger's dissent from the denial of *en banc* rehearing in *Hughes Aircraft Co.* v. *United States*, 148 F.3d 1384 (Fed. Cir. 1998). The concerns voiced by Judge Clevenger in that dissent do not bear on any issue in this case, and thus that dissent does not support Hester's request that its petition be granted.

The Federal Circuit's decision in *Hughes* addressed a very different issue from that presented in Hester's petition. *Hughes* concerns prosecution history estoppel as a limitation on the doctrine of equivalents. See *Hughes Aircraft Co.* v. *United States*, 140 F.3d 1470, 1475 (Fed. Cir. 1998). It does not even address the issue presented in Hester's petition—the recapture limitation on the scope of error correctable under § 251. But even if this Court chose to analogize these two disparate points of patent law and address them within a common framework, it would find nothing in the *Hughes* decision that either contradicts or calls into question what the Federal Circuit did in its unanimous decision in this case.

Hester's petition questions what acts (*e.g.*, amendment, cancellation, and argument) may work a surrender of subject matter that cannot be remedied in reissue. The analogous question—what acts may work a prosecution history estoppel—is not raised in *Hughes*. In *Hughes*, the patent applicant narrowed its claims in response to a prior art rejection. *Hughes Aircraft*, 140 F.3d at 1477. The Federal Circuit found that this prosecution history would "serve to narrow the range of equivalents," but held that this narrowing "did not surrender" the specific subject matter accused of infringement. *Ibid.* Judge Clevenger's dissent proposes that the latter holding is inconsistent with *Warner-*

Jenkinson Co. v. *Hilton Davis Chem. Co.*, 520 U.S. 17 (1997). Specifically, Judge Clevenger read *Warner-Jenkinson* as suggesting that *any* assertion of equivalents for amended claim limitations is foreclosed. 148 F.3d at 1385-1386.

Whatever the importance of the *Hughes* issue (*i.e.*, whether prosecution history estoppel bars all access to the doctrine of equivalents, without need to examine what subject matter is specifically surrendered), that issue is not raised in this case. Hester does not question that the subject matter it surrendered by argument was sought (and obtained) in its broadened reissue claims. Hester questions only whether it actually surrendered that subject matter in the first instance. *Hughes* does not address that question, either directly or by analogy. Accordingly, Judge Clevenger's dissent adds no weight to Hester's petition.

Respectfully submitted.

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